

REMARKS

I. STATUS OF THE CLAIMS

Claims 21-38 and 42-52 are now pending in this application. Claims 21, 31-33, 37, and 47-52 have been amended to more particularly point out and distinctly claim the present invention. Without prejudice or disclaimer, the limitations of claims 39-41 have been incorporated into claim 37, and thus claims 39-41 have been canceled. The amendments are supported by the specification (see, e.g., Specification at pages 2-4) and the claims as-filed. Accordingly, no new matter has been added by these amendments, nor do these amendments raise new issues or necessitate the undertaking of any additional search of the art by the Examiner.

In addition, Applicants' representatives wish to thank the Examiner for the courtesies extended to them during the personal interview on June 27, 2005. The amendment and remarks submitted herewith are intended to supplement and clarify the discussion of that date.

III. REJECTION OF CLAIM 37 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claim 37 stands rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing new subject matter, "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Office Action at 2. Specifically, the Examiner contends that there is no support at page 10, 2nd paragraph of the specification for the recitation of "ketones, alkyl acetates, and di-alkoxy substituted alkanes," in claim 37. *Id.* The Examiner continues to argue that "[d]escription for two specific compounds in each category [i.e., ketones, alkyl acetates,

and di-alkoxy substituted alkanes] is not a support for the entire genus.” *Id.* at 3.

Further, the Examiner rejects Applicants’ previous argument that the recitation of at least two species can be representative of a genus.

Applicants continue to respectfully disagree with the Examiner. However, in the interest of advancing prosecution, Applicants have amended claim 37 to include the limitations of claims 39-41. Accordingly, the Examiner’s rejection is now moot, and Applicants respectfully request that the rejection of claim 37 under 35 U.S.C. § 112, first paragraph should be withdrawn.

IV. REJECTIONS UNDER 35 U.S.C. § 102(b)

A. Claims 21-26, 28-38, 42, 47, 49, and 52 in view of Robertson

The Examiner rejects claims 21-26, 28-38, 42, 47, 49 and 52 under 35 U.S.C. § 102(b) as allegedly anticipated in view of U.S. Pat. No. 5,053,221 to Robertson et al (“Robertson”), focusing on Robertson’s disclosure of “silica beads.” Office Action at 4-5.

Applicants respectfully traverse the rejection for at least the reasons of record, as well as those set forth below.

A claim is anticipated under 35 U.S.C. § 102(b) only if each and every element as set forth in the claim is found in a single reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) and M.P.E.P. § 2131. Furthermore, the identical invention must be set forth in as complete detail as it appears in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) and M.P.E.P. § 2131. Robertson cannot be said to anticipate the present invention because it does not disclose each and every element of the present claims.

Specifically, not only is there no teaching or disclosure in Robertson that the compositions disclosed therein exhibit the claimed detachment profile, but there is also no teaching or disclosure that the compositions of Robertson comprise at least one “branched sulfonic adhesive polymer” as required by the currently amended claims. See, e.g., claim 21 as-amended. The Examiner contends that the anticipation rejection “is not based upon inherency, but for the reason that the patent office is not equipped to verify the criteria recited in the claim.” Office Action at 3. However, the Examiner supports her anticipation argument, in part, by stating, “[s]ee the paragraph bridging col.s 3-4 for the adhesive polymer and see col.4, lines 18 et seq and col.5, lines 1-60 for the AQ polymers. The polymer disclosed in the patent reads on the claimed adhesive polymer,” without offering any proof that the polymers are the same. Office Action at 5. Thus, the Examiner improperly rejects the claims based on the assumption that the AQ polymers disclosed in Robertson anticipate the present claims, without the Examiner offering any evidence and, supposedly, without relying on inherency.

Applicants respectfully point out to the Examiner that the AQ polymers cited in Robertson, AQ29S, AQ38S, AQ55S, AQ29D, AQ38D, and AQ55D, are all linear sulfonic polymers, as shown by Formula (I) in Robertson. The fact that these polymers are linear is further reinforced by the Appendices submitted to the Examiner with the Response of June 9, 2004. See, e.g., “Eastman AQ 55S and Eastman AQ 38S,” submitted on June 9, 2004, as Appendix D, at page 1 (“Eastman AQ polymers are linear polyesters consisting of two types of alternating monomers”). Accordingly, Robertson at least does not disclose the claimed branched sulfonic adhesive polymers.

Therefore, for at least the foregoing reason, Applicants respectfully submit that the rejection of claims 21-26, 28-38, 42, 47, 49 and 52 under 35 U.S.C. § 102(b) in view of Robertson is improper and should be withdrawn.

B. Claims 21-27, 30-33, 38, 42, 47, 49, and 52 in view of Robertson

The Examiner rejects claims 21-27, 30-33, 38, 42, 47, 49, and 52 under 35 U.S.C. § 102(b) as allegedly anticipated in view of U.S. Pat. No. 5,053,221 to Robertson et al (“Robertson”), focusing on Robertson’s disclosure of “silicone powders” Office Action at 5-6.

Applicants respectfully disagree with the Examiner and assert that the rejection is improper in view of the presently amended claims. As discussed above, Robertson does not disclose at least the claimed “branched sulfonic adhesive polymer.”

Therefore, for at least the foregoing reasons, Applicants respectfully submit that the rejection of claims 21-27, 30-33, 38, 42, 47, 49 and 52 under 35 U.S.C. § 102(b) in view of Robertson is improper and should be withdrawn.

C. Claims 50-52 in view of Jacquet

The Examiner rejects claims 50-52 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,150,115 to Jacquet et al. (“Jacquet”). See Office Action at 6-7. In particular, the Examiner contends that the “[p]olymer of example 2 reads on the adhesive polymer and the dyes disclose reads on the solid particles.” *Id.* at 7.

Applicants respectfully traverse this rejection that Jacquet does not anticipate the currently amended claims. Jacquet does not teach or disclose that its compositions would exhibit the claimed detachment profile, and moreover, it does not teach or

disclose that its compositions comprise “branched sulfonic adhesive polymers” as claimed. See, e.g., claim 50 as-amended.

Therefore, for at least the foregoing reasons, Applicants respectfully submit that the rejection of claims 50-52 under 35 U.S.C. § 102(b) in view of Jacquet is improper and should be withdrawn.

V. REJECTIONS UNDER 35 U.S.C. § 103(a)

A. Claims 47-48 and 52

The Examiner rejects claims 47-48 and 52 under 35 U.S.C. § 103(a) as being obvious over Robertson in view of U.S. Patent No. 5,639,448 to Galleguillos et al. (“Galleguillos”). See Office Action at 8-9. Specifically, the Examiner admits that Robertson “does not teach the use of adhesive polymers for styling.” Office Action at 9. Thus the Examiner relies on Galleguillos to cure the deficiencies of Robertson, asserting that Galleguillos teaches “the same adhesive polymers, which are aryl-sulfonated polymers for styling the hair.” *Id.*

Applicants respectfully traverse this rejection at least because the Examiner has not established a prima facie showing of obviousness. One of the requirements to establish a prima facie case of obviousness dictates that the references cited by the Examiner must at least teach or suggest all of the claim limitations. See M.P.E.P. § 2143. As discussed above, Robertson does not teach or suggest all of the present claim limitation. Specifically, the compositions of Robertson do not comprise “branched sulfonic adhesive polymers,” nor do the compositions exhibit the claimed detachment profile.

Galleguillos cannot cure the deficiencies of Robertson because Galleguillos discloses the same polymers, Eastman AQ Polymers 55, 38, and 29, which are linear and not branched. Moreover, Galleguillos does not teach that the compositions with such polymers would exhibit the claimed detachment force. Thus, the references cited by the Examiner do not teach or disclose all elements of the claimed invention, and therefore a prima facie case of obviousness has not been shown.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that the rejection of claims 47-48 and 52 under 35 U.S.C. § 103(a) in view of Robertson and Galleguillos is improper and should be withdrawn.

B. Claims 21-47, 49 and 52

The Examiner rejects claims 21-47, 49 and 52 under 35 U.S.C. § 103(a) as obvious over Robertson in view of U.S. Patent No. 6,495,119 ("Sturla") and further in view of U.S. Patent No. 5,932,201 to de Labbey et al. ("de Labbey"). See Office Action at 9-11. Specifically, the Examiner admits that Robertson "does not teach the limitations claimed in claims 39-41 drawn to solvents and additives claimed in claims 43-45." Office Action at 10. Thus the Examiner relies on Sturla and de Labbey to cure the deficiencies of Robertson, asserting that Sturla teaches "compositions using the specific solvents claims at col.6, lines 35-53 and also at lines 65-67," and that de Labbey "teaches compositions using thiols and silicones." *Id.*

Applicants respectfully traverse this rejection at least because the Examiner has not established a prima facie showing of obviousness. As discussed above, one of the requirements to establish a prima facie case of obviousness is that the references cited

by the Examiner must at least teach or suggest all of the claim limitations. See M.P.E.P. § 2143.

Applicants have established above that Robertson does not teach or suggest all of the present claim limitations. Specifically, the compositions of Robertson do not comprise "branched sulfonic adhesive polymers," nor do the compositions exhibit the claimed detachment profile. Neither Sturla nor de Labbey can cure the deficiencies of Robertson.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that the rejection of claims 21-47, 49 and 52 under 35 U.S.C. § 103(a) in view of the combination of Robertson, Sturla, and de Labbey is improper and should be withdrawn.

VI. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

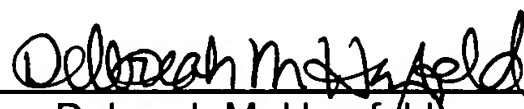
If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, she is respectfully urged to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2005

By: 
Deborah M. Herzfeld
Reg. No. 52,211